

PRE-APPEAL BRIEF REQUEST FOR REVIEW
(filed with the Notice of Appeal)

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First Named Inventor
Aaltonen et al.

Art Unit
2457

Examiner
Michael C. Lai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Attachment

Reasons for Requesting Pre-Appeal Brief Request For Review

REMARKS/ARGUMENTS

These remarks are hereby filed concurrent with a Pre-Appeal Brief Request for Review, and following a final Official Action of January 6, 2009. The final Official Action continues to or now rejects all of the pending claims, namely Claims 1-6, 8-25, 27-42, 44-59 and 61-71, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,798,785 to Hendricks et al., in view of U.S. Patent No. 5,826,168 to Inoue et al; and now rejects Claims 1 and 8 under 35 U.S.C. § 112, second paragraph, for being indefinite. As explained below, Applicants respectfully submit that the claimed invention is definite and patentably distinct from Hendricks and Inoue, taken individually or in any proper combination. In view of the remarks presented herein, Applicants respectfully request reconsideration and withdrawal of the rejections of all of the pending claims.

A. *Functional Claim Language*

Initially, Applicants note that in the response to arguments section of the final Official Action, the Examiner appears to be suggesting a “statement of use” argument for discounting recitations of the claims. Official Action of Jan. 6, 2009, pp. 2-3. However, Applicants respectfully submit that functional language, such as “configured to,” is definite and acceptable claim language. Section 2173.05(g) of the MPEP defines a functional limitation as “an attempt to define something by what it does, rather than what it is (e.g., as evidenced by its specific structure or specific ingredients).” In this regard, a functional limitation is often used in association with an element to “define a particular capability or purpose that is served by the recited element, ingredient or step.” *Id.* More particularly, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) has held that the limitations “adapted to be fitted,” “adapted to be affixed” and “adapted to be positioned,” “serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.” MPEP § 2173.05(g), *citing In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976) (emphasis added).

Moreover, and more particularly with respect to similar functional language, “configured to,” Applicants note that it has been held that an apparatus configured (e.g., programmed) to perform various steps or functions creates a new apparatus. *See In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994); and *see id.* at 1569-1570 (Newman, concurring) (“Alappat’s rasterizer is an electronic device for displaying a smooth waveform by selective illumination of pixels. The Alappat rasterizer operates by performing a sequence of steps in accordance with instructions that are generated electronically. ... The structure resides in the configuration by which the device operates, as [the majority] has explained, and is independent of how that configuration is provided.”) (emphasis added).

Applicants therefore respectfully submit that to the extent the claims of the present application include structure positively performing various functions, or include components configured to perform various functions, those limitations must be evaluated and considered like any other claim limitation.

B. Claims 1 and 8 are Definite

The final Official Action rejects Claims 1 and 8 under 35 U.S.C. § 112, second paragraph, for being indefinite; the Examiner alleging that “the term ‘its’ renders the claim indefinite because it is unclear what exactly ‘it’ is referring to.” Official Action of Jan. 6, 2009, p. 4. Applicants respectfully disagree, and submit that in accordance with simple English grammar, the claims are in fact clear as to the term “its.” Independent Claim 1 (and similarly Claim 8) recite that a terminal is triggered to obtain “its” location (i.e., “a trigger to the terminal to obtain its location, the terminal being configured to obtain its location in response to the trigger”). Applicants submit that as clearly recited by Claims 1 and 8 “its” refers to the terminal – that is, Claims 1 and 8 clearly refer to the terminal obtaining the terminal’s (i.e., “its”) location. See also Merriam-Webster’s Online Dictionary, *Definition of its* (visited Mar. 30, 2009) <<http://www.merriam-webster.com/dictionary/its>> (defining “its” as follows: “of or relating to it or itself especially as processor, agent, or object of an action”).

C. Claims 1-6, 8-10, 20-25, 27, 28, 37-42, 44, 45, 54-59, 61, 62 and 71

The Official Action rejects Claims 1-6, 8-10, 20-25, 27, 28, 37-42, 44, 45, 54-59, 61, 62 and 71 as being unpatentable over Hendricks, in view of Inoue. In contrast to independent Claim

1, neither Hendricks nor Inoue, taken individually or in any proper combination, teaches or suggests a terminal accessing the content (with which the content usage statistic(s) are related) from memory of the terminal at some point in time after having received the content, that access of content triggering the terminal to obtain its location and store content usage statistic(s) including the location. The Official Action cites Hendricks for allegedly disclosing this feature of independent Claim 1. In this regard, the Official Action cites the four-bit address of a set-top terminal in a polling-request response message (as in FIG. 7b) as allegedly corresponding to the recited terminal location. Even if one could argue that the set-top terminal address of Hendricks corresponds to a location of that terminal (the accuracy of which is expressly not admitted), however, nowhere does Hendricks teach or suggest that its terminal accesses content from memory, and that this access triggers the terminal to obtain its location (address) and store statistics including that location, similar to independent Claim 1 reciting that accessing content from memory triggers the terminal to obtain its location and store statistic(s) including that location.

Hendricks discloses the set-top terminal receiving a polling request message addressed to the terminal, and sending to the requesting headend, a response message including its address and information (program access information) related to the terminal's access of broadcast programs. One may argue that the set-top terminal of Hendricks inherently stores its address in memory (although the accuracy of this argument is expressly not conceded). At best, then, one may argue that Hendricks' set-top terminal may obtain its address (location) from the polling request message or its own memory (for inclusion in the response message). In neither instance, however, does the terminal accessing content from its memory trigger the terminal to obtain its address, similar to independent Claim 1. Rather, in both instances, at best one may argue that the terminal receiving the headend polling request triggers the terminal obtaining its address. The Examiner in the final Official Action even admits of this interpretation, stating: "Since the response message includes the terminal's address, the terminal must obtain its location in response to the request." Official Action of Jan. 6, 2009, p. 3. Again, instead of a terminal obtaining its location in response to a request, independent Claim 1 recites that accessing content from the terminal's memory triggers the terminal to obtain its location.

Applicants therefore respectfully submit that independent Claim 1, and by dependency Claims 2, 3, 6 and 8-10, is patentably distinct from Hendricks and Inoue, taken individually or in

any proper combination. Applicants submit that independent Claims 20, 37 and 54 recite subject matter similar to that of independent Claim 1, including triggering obtaining the location of a terminal or apparatus by accessing content from memory in an offline manner (Claim 20), or memory of the terminal or apparatus in an offline manner (Claims 37 and 54), and storing content usage statistic(s) including the location. Applicants therefore respectfully submit that independent Claims 20, 37 and 54, and by dependency Claims 21, 22, 25, 27, 28, 38, 39, 42, 44, 45, 55, 56, 59, 61, 62 and 71, are also patentably distinct from Hendricks and Inoue, taken individually or in any proper combination, for at least the reasons given above with respect to independent Claim 1.

D. Claims 11-19, 29-36, 46-53 and 63-70

The Official Action rejects Claims 11-19, 29-36, 46-53 and 63-70 as being unpatentable over Hendricks, in view of Inoue. As to independent Claim 11, the Official Action concedes that Hendricks does not teach or suggest pre-broadcast content. Nonetheless, the Official Action alleges that Inoue discloses this feature, and that it would have been obvious to one skilled in the art to modify Hendricks to include the feature. Even considering Inoue, however, Applicants respectfully submit that neither Hendricks nor Inoue, taken individually or in combination, teach or suggest a terminal accessing pre-broadcast content (including broadcast content) from memory, storing statistics related to that access, and sending those statistics to a destination before the related broadcast content is broadcast.

Applicants note that independent Claim 11 recites accessing pre-broadcast content (including broadcast content) from memory and sending statistics related to that access before the broadcast content is broadcast. Independent Claim 11 therefore inherently requires availability of broadcast content (of the pre-broadcast content) from memory before that broadcast content is broadcast – otherwise, the broadcast content (of the pre-broadcast content) may not be accessed from memory, as explicitly recited. By contrast, Inoue is premised on recording content as that content is broadcast, and therefore does not support availability of broadcast content from memory before its broadcast. Inoue may disclose broadcasting the same content on multiple channels in a time-delayed manner. But even given this feature, no content of Inoue is available from memory before its broadcast since it's by broadcast of the content that the content is recorded and made available in memory.

Moreover, Applicants respectfully submit that to the extent that one may argue (albeit incorrectly) that content broadcast on another channel from which that content is recorded may be interpreted as recording (and thus, making available in memory) content before its broadcast, Applicants respectfully submit that there is no apparent reason why one skilled in the art would modify Hendricks, Inoue or their combination as alleged. The Official Action alleges that one skilled in the art would be motivated to modify Hendricks and Inoue "to try to collect pre-broadcast statistics by receiving content usage statistics before the broadcast content is broadcast, thereby providing useful information about media sampling/promotion." Given that Inoue discloses multiple, partially-overlapping broadcasts of content, however, only a short interval is available between the broadcast of content on multiple channels. Examples according to Inoue include a time delay of fifteen or seventeen minutes for a two-hour broadcast. Thus, according to the asserted modification of Hendricks and Inoue, not only would a user have to access recorded content from memory within this fifteen/seventeen minute window, but that user's terminal would have to send statistics related to that access within that window. Applicants question, however, the extent to which one skilled in the art would have an apparent reason to modify Hendricks and Inoue to not only presume access of stored content within this short of a window, but also require sending of statistics relating to that access, within that short of a window, particularly given that the destination would likely not realize any benefit from receiving such statistics before the next broadcast of the content.

Applicants therefore respectfully submit that independent Claim 11, and by dependency Claims 12-19, is patentably distinct from Hendricks and Inoue, taken individually or in any proper combination. Applicants submit that independent Claims 29, 46 and 63 recite subject matter similar to at least those portions of independent Claim 11 that are discussed above, including storing, into a content usage log, content usage statistics relating to accessing piece(s) of pre-broadcast content from memory; and sending the statistics to (or receiving the statistics at) a destination before the related broadcast content is broadcast. Applicants therefore respectfully submit that independent Claims 29, 46 and 63, and by dependency Claims 30-36, 47-53, 64-70, are also patentably distinct from Hendricks and Inoue, taken individually or in combination, for at least the reasons given above with respect to independent Claim 11.